

**REMARKS**

**I. INTRODUCTION**

Applicants appreciate holding an interview with the Examiner and Applicants' representative on September 3, 2009 (the "Interview"). A copy of the Interview Summary dated September 3, 2009, which was provided by the Examiner following the Interview, is attached hereto.

Previously-submitted Figs. 4-9 have been replaced with modified Figs. 4-9, which are filed herewith on separate "Replacement" sheets. Claims 1-62, 94, 110-112, and 124 were previously canceled, claims 74, 88, 89, 91, 108, 109, 138, 139, and the second occurrence of claim 88 (renumbered as claim 89 herein) are canceled herein. Claims 63 and 113 have been amended above to clarify the subject matter recited therein, but not for any reason relating to patentability thereof, and to place the claims in a better appeal and/or allowance.

Accordingly, claims 63-73, 75-87, 90, 92, 93, 95-107, 113-123 and 125-137 are now under consideration in the present application. Provided above, please find separate "Replacement" sheets for the drawings, and a claim listing indicating the status of the current amendments to the previously-pending claims and cancellation of other claims on separate sheets so as to comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

**II. OBJECTIONS TO THE DRAWINGS SHOULD BE WITHDRAWN**

The Examiner objected to previously-submitted Figs. 4-9 due to minor informalities. (See Office Action, page 2). As the Examiner shall ascertain, previously-submitted Figs. 4-9 have been replaced with modified Figs. 4-9, which are submitted

herewith on separate "Replacement Sheets." Support for the added text labels is provided in the originally-filed specification, e.g., in the paragraphs describing each of the respective figures. Accordingly, Applicants respectfully request that the objections to Figs. 4-9 be withdrawn.

The Examiner also objected to the drawings under 37 C.F.R. §183(a), stating that the drawings must show every claimed feature of the invention. Specifically, the Examiner alleged that the features of "the target area has an area of about one square centimeter," "the "at least one hundred of the particular areas," and "the at least one thousand of the particular areas" recited, *inter alia*, in claims 88, 89, 91, 108, 109, 138, and 139, are not shown in the drawings.

To expedite the prosecution of the present application, claims 88, 89, 91, 108, 109, 138, and 139 have been cancelled herein above without prejudice herein, thus rendering the objection to these claims moot.

### **III. OBJECTION UNDER 35 U.S.C. § 132(a) SHOULD BE WITHDRAWN**

The Examiner objected to the amendment to the present application filed on March 27, 2003 under 35 U.S.C. § 132(a), and alleges that the amendment introduced new matter into the disclosure. (See Final Office Action, page 4). Specifically, the Examiner alleged that the recitation of damage "from a surface of the skin through an entire depth of the epidermal tissue" is not supported by the original disclosure. Applicants respectfully disagree.

As indicated to the Examiner during the Interview, regions of damage that include the epidermis and parts of the dermis are described, *inter alia*, in paras. [0003], [0043], [0044], [0059] of the published application. For example, para. [0059] states: "the

thermal skin damage caused to individual exposure areas 716 extends **through the epidermal tissue 710 and into the dermal tissue 712** only to a predetermined depth.”

Further, FIGS. 1C and 7B of the originally-filed specification clearly illustrate regions of damage (130 and 716, respectively) that extend from the skin surface through the entire depth of the epidermal tissue, and into the dermis. These drawings of the originally-filed disclosure of the present application provide further enabling support for the amendment filed on March 27, 2003. For example, the Board of Appeals and Interferences has held that patent figures may also provide support for recited claim features. See *Ex parte Nomula*, BPAI Appeal 2007-0656 (2007), citing *In re Mraz*, 455 F.2d 1069, 1072, 173 USPQ 25, 27 (CCPA 1972) (“Generally, features clearly shown by patent drawings cannot be disregarded.”), and further citing *In re Wolfensperger*, 302 F.2d 950, 955, 133 USPQ 537, 542 (CCPA 1962) ...when assessing whether a drawing provides descriptive support for a claim feature the ‘legitimate enquiry in each case ... is what the drawing in fact discloses to one skilled in the art.’”).

As further indicated to the Examiner during the Interview, Applicants respectfully submit that these originally-filed figures, taken in conjunction with the description of the epidermal damage in the original specification cited above, clearly support the recitation of damage “from a surface of the skin through an entire depth of the epidermal tissue.”

In fact, during the Interview, the Examiner agreed that such subject matter is supported by the originally-filed disclosure of the present application. (See Interview Summary dated September 3, 2009, p. 2).

Accordingly, Applicants respectfully request that the objection to the previous amendment under 35 U.S.C. § 132(a) be withdrawn.

**IV. REJECTIONS UNDER 35 U.S.C. § 112 SHOULD BE WITHDRAWN**

Claims 70, 71, 80, 81, 100, 101, 120, 121, 130, and 131 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. (See Final Office Action, page 5). In the Final Office Action, the Examiner alleged that these claims contain subject matter which was purportedly not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner contended that the originally filed disclosure is silent with respect to the described tissue damage being “from a surface of the skin through an entire depth of the epidermal tissue.” (*Id.*) Applicants respectfully disagree.

As noted above, it was indicated to the Examiner during the Interview that regions of damage that are formed from the skin surface through the entire depth of the epidermis and into the dermis are described in the original specification of the present application, *inter alia*, in paras. [0003], [0043], [0044], [0059], and in FIGS. 1C and 7B of the published application.

Applicants respectfully submit that these descriptions and figures clearly convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, including the recited feature of forming regions of damage “from a surface of the skin through an entire depth of the epidermal tissue.”

As indicated above, during the Interview, the Examiner agreed that such subject matter is supported by the originally-filed disclosure of the present application. (See Interview Summary dated September 3, 2009, p. 2).

Accordingly, Applicants respectfully request that this rejection of claims 70, 71, 80, 81, 100, 101, 120, 121, 130, and 131 under 35 U.S.C. §112, first paragraph, be withdrawn.

Turning to the §112, second paragraph rejections, claims 64 and 114 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. (See Final Office Action, page 5). Specifically, the Examiner alleged that these claims fail to further limit the claims from which they depend. Claim 63 recites that the damage be “from the skin surface through an entire depth of the epidermal tissue.” The Examiner contends that the only laser disclosed in the originally filed disclosure is an ablative laser. Applicants respectfully disagree with this statement.

Indeed, claim 63 recites that electromagnetic radiation from a radiation source is adapted to ablate or cause thermal damage to epidermal and dermal tissue within the target area. The Examiner apparently believes that the only originally disclosed radiation source that can generate this result is an ablative laser, and thus the recitation in claim 64 that the radiation source is an ablative laser does not further limit claim 63. Applicants note that claim 63 recites that the radiation source “is adapted to at least one of ablate **or cause thermal damage**” to the skin tissue. Applicants further note that other electromagnetic radiation sources adaptable to cause thermal damage to the entire thickness of the epidermis and a portion of the dermis are disclosed in the original specification. For example, para. [0040] of the published application provides that the

EMR source can be a laser, a flashlamp, a tungsten lamp, a diode, a solid state laser, a gas laser, a diode laser, or a diode array. These disclosed EMR sources do not have to be ablative, and may merely cause thermal damage (e.g., heating) of the treatment regions. Claim 63 is not limited to an EMR source that must cause ablative damage, whereas claim 64 recites an ablative laser. Corresponding arguments also apply to claim 114, which Applicants respectfully assert provide a further limitation to claim 113 from which it depends.

Claim 74 has been canceled as provided herein above, rendering the rejection of that claim under 35 U.S.C. §112, second paragraph moot.

Claims 88, 89, 91, 108, 109, 138, and 139 also stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. (See Final Office Action, page 5). The Examiner alleged that it is unclear exactly what range of areas is encompassed by the recitation of “about one square centimeter” in these claims. Applicants respectfully disagree, and respectfully submit that this recitation is abundantly clear and unambiguous to one of ordinary skill in the relevant art. Support for the recitation of a target area having a surface area of approximately 1 cm<sup>2</sup> is provided in the originally-filed specification of the present application, at least in originally-filed claim 91. Nevertheless, to expedite prosecution of the present application, claims 88, 89, 91, 108, 109, 138, and 139 were cancelled herein above, thus rendering this rejection moot. Applicants reserve the right to pursue the subject matter of the canceled claims in one or more continuing applications which would claim priority from the present application and other applications from which the present application claims priority.

Accordingly, for at least the reasons as set forth herein above, Applicants respectfully assert that the rejection of the above-referenced claims under 35 U.S.C. §112, second paragraph, should be withdrawn.

**V. REJECTION UNDER 35 U.S.C. § 102 SHOULD BE WITHDRAWN**

Claims 63-70, 72-80, 82-87, 90-93, 95-100, 102-107, 113-120, 122, 123, 125-130, and 132-137 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by U.S. Patent Publication No. 2003/0216719<sup>1</sup> of Debenedictis et al. (the "Debenedictis Publication"). (See Final Office Action, page 5). Applicants respectfully traverse this rejection.

The Debenedictis Publication was filed as a continuation-in-part ("CIP") application of and claims priority from two earlier applications, i.e., U.S. Application No. 10/279,093 of Debenedictis and Voevodkin, filed on October 22, 2002 (the "parent '093 Application"), and U.S. Application No. 10/278,582 of Black and Eimerl, filed on October 23, 2002 (the "parent '582 Application").

As an initial matter, Applicants respectfully note that relevant portions of the Debenedictis Publication relied on by the Examiner in these claim rejections were not disclosed in the parent '582 Application. For example, the parent '582 Application from which the Debenedictis Publication claims priority fails to provide, *inter alia*, any description of *generating regions of ablation or thermal damage that extend from the tissue surface to a location within the dermis*, as recited in the presently-pending independent claims of Applicants' application. Accordingly, the earliest priority date for

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<sup>1</sup> This publication is erroneously referred to in the Office Action as "WO 2003/0216719," but is correctly identified in the Notice of References Cited attached thereto.

the features relied on by the Examiner in the present claim rejections based on the Debenedictis Publication under 35 U.S.C. §102(e) is the filing date of the parent '093 Application, i.e., October 22, 2002.

Accompanying this response is the Declaration under 37 C.F.R. § 1.131 of Dieter Manstein, which is submitted to effectively antedate the '093 Application and the '582 Application, to each of which the Debenedictis Publication claims priority. In particular, such declaration confirms that the subject matter recited in independent claims as currently-pending herein was invented and reduced to practice prior to the filing date of the parent '093 Application, i.e., before October 22, 2002.

Further, claims 74 and 91 have been cancelled above, without prejudice. Thus, the 35 U.S.C. § 102 rejection of these claims is moot.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(e) of claims 63-70, 72, 73, 75-80, 82-87, 90, 92, 93, 95-100, 102-107, 113-120, 122, 123, 125-130, and 132-137 are respectfully requested.

#### **VI. REJECTION UNDER 35 U.S.C. § 103 SHOULD BE WITHDRAWN**

Claims 63-93, 95-109, and 113-139 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Debenedictis Publication, in combination with International Patent Publication No. WO 2002/053050 by Altshuler et al. (the "Altshuler Publication") and U.S. Patent No. 6,517,532 to Altshuler et al. (the "Altshuler Patent"). (See Final Office Action, page 6).

Accompanying this response is the Declaration under 37 C.F.R. § 1.131 of Dieter Manstein, which is submitted to effectively antedate the Debenedictis Publication relied on by the Examiner, and the parent '093 Application from which the Debenedictis



Publication claims priority. The remaining relied-on references, i.e., the Altshuler Publication and the Altshuler Patent, without combining them with the antedated Debenedictis Publication, do not teach or suggest the subject matter recited in the presently-pending independent claims of the present application, either taken alone or in an alleged combination.

Further, claims 74, 88, 89, 91, 108, 109, 138, 139 have been cancelled above, without prejudice. Thus, the 35 U.S.C. § 103 rejection of these claims is moot.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 of claims 63-73, 75-87, 90, 92, 93, 95-107, 113-123 and 125-137 are respectfully requested.

**VII. CONCLUSION**

In light of the foregoing, Applicants respectfully submit that all arguments raised in the Office Action have been addressed and that all pending claims 63-73, 75-87, 90, 92, 93, 95-107, 113-123 and 125-137 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Examiner is invited to contact the undersigned to expedite the prosecution of this application if any issues remain outstanding.

Respectfully submitted,



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By: \_\_\_\_\_

Gary Abelev  
Patent Office Reg. No. 40,479

DORSEY & WHITNEY, L.L.P.  
250 Park Avenue  
New York, New York 10177

Attorney for Applicants  
(212) 415-9200

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